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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,828	05/02/2001	Russell F. McKnight	2098	6296

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EXAMINER	
RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/847,828	MCKNIGHT ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

With respect to the IDS that is citing US patent 6081813, this patent number has apparently been withdrawn and the examiner cannot view the disclosure. This document is not in the USPTO patent database and the examiner does not have a copy to review. This reference has not been considered and has been crossed out on the 1449 statement for this reason.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 12,30, the preamble states "via a network", but the examiner notes that in the body of the claim there is no network recited. It is not clear if the computing resources are being provided via a network as the preamble indicates. The examiner is not clear as to whether or not there is a network being used in this method claim because the body of the claim lacks any mention of a network. There is also no antecedent basis for "the negotiated agreement". Is this the same as the agreement from line 3 or another agreement that was not previously claimed? No negotiated agreement has previously been recited.

For claim 15, there is no antecedent basis for "wherein the step of negotiating an agreement with a customer". It was not claimed that an agreement was negotiated so

what step does this refer to? It has only been claimed that an agreement was entered into, which does not require negotiation. This step lacks antecedent basis.

For claims 22-29, it is not clear to the examiner as to what statutory class of invention the claims are directed to. Are the claims directed to a method or a system? Claim 22 recites two structural elements but has 4 recitations to method steps so even though the preamble indicates a "system", the examiner is not clear as to what statutory class these claims are reciting. The language "a plurality of information handling systems furnishing computing resources..." is a recitation to structure and is also reciting that the information handling systems are doing something (furnishing). This is a method of use limitation. Are claims 22-29 article or method claims? The dependent claims add further confusion to this issue because they also recite method steps directed to steps of use.

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22-29 are rejected under 35 U.S.C. 101 because the claimed invention is written in a manner that seems to be a mix of statutory classes (apparatus and method). The claims are directed to more than one statutory class of invention, which is improper.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 22-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Kraft et al. (6112225).

The examiner has examined claims 22-29 as if they are apparatus claims. Kraft discloses a system manager 102 and a plurality of information handling systems 106. The computers 106 are disclosed as providing distributed computing services. The language directed to how the computing resources have been acquired has been considered but it not reciting any further structure to the system. The manner by which the computer resources are acquired does not result in any structure that is not found in Kraft. The limitations recited in claims 23-29 are directed to method steps and do not result in any structure being claimed that is not found in Kraft.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-4,6-9,11-19,21,30,31,33, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al. (6112225).

For claim 1,6,7,11,12,15,21,30,33, Kraft discloses a method of providing distributed computing services as claimed. Kraft discloses that complex tasks can be broken up into smaller tasks and these smaller tasks are sent to customer's PC's via the Internet for processing. Kraft discloses the act of providing a reward to the owner of the PC for their participation in the distributed computing network. Not disclosed is the step of receiving an order for an information handling system as claimed. Also not disclosed is the step of leasing the computing resources from the customer. With respect to the receiving of an order for an information handling system, because the customers in Kraft have PC's that participate in the distributed computing the computers must have been obtained in some manner. One well-known manner of obtaining a computer is to purchase one. It would have been obvious to one of ordinary skill in the art at the time

the invention was made for the customer to purchase their PC from a computer retailer (the retailer receives an order from the customer) because this is the old and notoriously well known manner of obtaining a computer. This is easier than making a computer, which not many people are capable of doing. With respect to the step of leasing the computing resources, Kraft discloses that customers are rewarded for their participation in the distributed computing network. Column 9, line 62-column 10, line 4 discloses that rewards are given to owners of computers that participate in the distributed computing. This can be in the form of money. The situation disclosed in Kraft is essentially an agreement that the owner will make their PC available for distributed computing tasks, and the owner will receive compensation for making the computer resource available. It would have been obvious to one of ordinary skill in the art at the time the invention was made to lease the computing resources from the PC owner, so that the agreement was more formalized and both parties knew what they would receive from the other.

For claims 2,3,7,8,12,13,31, applicant has claimed the configuring of the information handling system for providing the computing resources. The examiner interprets this to be the act of providing the owner's PC with a processor, database, and a modem. These features allow distributed computing to occur. This is clearly done prior to delivery to the owner as claimed.

For claims 4,9,14, see column 9, line 62-column 10, line 4 where the claimed incentive is disclosed.

For claims 16,17, not disclosed is the step of determining whether or not the customer is in compliance with the agreement, and if they are not in compliance,

discontinuing the incentive. The examiner feels that one of ordinary skill in the art would find this obvious based on the level of ordinary skill in the art. Clearly, if you are providing compensation to the PC owner for using their PC for distributed computing, if they do not allow you to access their PC for the purpose of performing distributed computing, one of ordinary skill in the art would find it obvious to not provide the incentive. One of ordinary skill in the art would find it obvious to monitor compliance with the agreement and would discontinue the incentive if the owner was not honoring their portion of the agreement.

For claims 18,19, Kraft does not disclose what is claimed. It is old and well known that agreements, such as leases, have times periods associated with the term of the lease. If an expiration date were included in the lease, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine if the customer would like to continue with the distributed computing lease once the previous lease is expired. This is just the act of renewing a lease, which is nothing new and is old and well known in the art. Because an incentive was provided for the lease, it follows that a second incentive would be provided with the new lease. One of ordinary skill in the art would not expect a PC owner to enter into a lease unless they are getting something out of the deal (incentive).

9. Claims 5,10,20,32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al. (6112225) in view of Leighton et al. (6108703).

For claims 5,10,20,32, Kraft does not disclose that the distributed computing services are hosting content on the World Wide Web. Leighton discloses a method where a content provider for the Internet can distribute and replicate content data to many computer servers instead of having all the content stored on one server. This allows for faster retrieval of information and duplication of data in the event the main server is lost. The method of Leighton is a form of distributed computing in that many computers are employed instead of a large computer server. This allows large amounts of data to be efficiently stored and retrieved as discussed by Leighton. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Kraft with the ability to assist Internet content providers by allowing them to store content on individual owner's PC's as taught by Leighton and in return the PC owners would receive compensation, just like when their PC is used to number crunching. This would be another product/service that Kraft could provide and would be satisfied by utilizing the individual owner's PC systems.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "Companies create way to put idle PCs to work through Net", "Magnosoft Awarded to US patents, leading provider of Internet software and services recognized for Distributed Computing Innovations", "The secret life of the home computer", "Move in on to put idle computers to work", "DataSynapse announces

premium benefits package for broadband users who join the company's Distributed Computing Network", "PCs put to work byte by byte Power, A group of Internet entrepreneurs envisions harnessing the unused capacity of millions of home computers to solve important problems" "Are you ready for cooperative processing?", and Bonnell (5655081) are references that discuss distributed computing and the advantages it provides.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DENNIS RUHL
PRIMARY EXAMINER